



27 FEB 2009

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

Greenblum & Bernstein, P.L.C.  
1950 Roland Clark Place  
Reston, VA 20191

In re Application of  
OHHASHI et al.

Serial No.: 10/529,692

PCT No.: PCT/JP03/12502

Int. Filing Date: 30 September 2003

Priority Date: 30 September 2002

Atty. Docket No.: P27627

For: PHOSPHOLIPID DERIVATIVE

DECISION

This decision is issued in response to applicant's "Petition for Entry of Corrected Literal English Translation and Statement of Interview" filed 08 December 2008, which is being treated as a petition under 37 CFR 1.181.

### **BACKGROUND**

On 30 September 2003, applicant filed international application PCT/JP03/12502 which claimed a priority date of 30 September 2002. A copy of the international application, published in Japanese, was communicated to the United States Patent and Trademark Office from the International Bureau on 08 April 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 March 2005.

On 29 March 2005, applicant filed a transmittal letter (PTO-1390) for entry into the national stage in the United States, which was accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a purported English translation of the international application; and a preliminary amendment.

On 06 October 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration was required. The notification set a two-month time limit in which to respond.

On 06 December 2005, applicant filed a declaration/power of attorney executed by the eight joint-inventors. Additionally, applicant submitted a "Corrected Literal English Translation" of the international application.

On 01 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903) which set forth the date of receipt 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements as 06 December 2005 and a 35 U.S.C. 371 completion date of 06 December 2005. The Notification incorrectly indicated that a Substitute Specification was received at the United States Patent and Trademark Office on 06 December 2005.

In response to the Notice of Allowability mailed 09 October 2008, applicant submitted the present petition entitled "Petition for Entry of Corrected Literal English Translation and Statement of Interview."

### DISCUSSION

The Notice of Allowability mailed 09 October 2008 indicated that "the substitute specification filed 06 December 2005 has not been entered because it does not conform to 37 CFR 1.125(b) and (c)." As explained below, applicant indicates the 06 December 2005 translation of the international application was a "Literal English Translation of International Application PCT/JP03/12502," not a substitute specification.

Applicant states in the present petition that the purported English translation of the international application submitted on 29 March 2005 was not a "literal" translation of the international application. 35 U.S.C. 371(c)(2) requires applicants to submit an English translation of an international application originally filed in a language other than English. The Manual of Patent Examining Procedure §1893.01(d) states that "a translation that includes modification other than changes that have been properly accepted under PCT Rule 26 or 91 is unacceptable." Thus, the purported translation of the international application filed 29 March 2005 is considered defective.

As stated above, on 06 December 2005, applicant submitted a corrected English translation of the international application as filed. Applicant states that "the corrected English translation . . . includes no new matter."<sup>1</sup> The translation submitted 06 December 2005 will be considered the English translation of PCT/JP03/12502. With the filing of the new translation of International application PCT/JP03/12502 on 06 December 2005, the above-identified application will be given an international filing date of 30 September 2003 under 35 U.S.C. 363, and a date of 06 December 2005 under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4).

The Notification Of Acceptance, which indicated that a Substitute Specification was received at the United States Patent and Trademark Office on 06 December, is appropriately vacated.

---

<sup>1</sup>The United States Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the above statement regarding the (English) translation of the international application.

Deposit Account No. 19-0089 will be charged a \$130.00 processing fee under 37 CFR 492(i) for supplying an English translation later than 30 months from the earliest claim priority date, as authorized.

**CONCLUSION**

The petition under 37 CFR 1.181 is **GRANTED**.

This application is being returned to the National Stage Processing Branch of the Office Of PCT Operations for processing in accord with this decision, including: (1) entering the 06 December 2005 English translation of the international application; (2) issuing a corrected Notification Of Acceptance, which indicates the submission date of the translation of international application as 06 December 2005; and (3) returning the application to Art Unit #1796 for further consideration.



Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298  
Fax: (571) 273-0459